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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,002	10/17/2001	Christoph Andreas Roth	8932-266	3810

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EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 12/23/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,002

Applicant(s)

ROTH ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-21, 27, 28 and 31-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-26, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Invention III (claims 22-30) and Species I (Figures 1-12A, 13-18) in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, **the election has been treated as an election without traverse** (MPEP § 818.03(a)).

It is acknowledged that applicant believes claims 22-26 and 29-30 read on the elected invention and that all the claims 22-26 and 29-30 are generic claims. The examiner agrees with applicant.

Claims 1-21, 27, 28, and 31-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected Inventions and/or Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Specification

The disclosure is objected to because of the following informalities:

On page 1, line 5, the application number for the related application is missing.

Appropriate correction is required.

Claim Objections

Claim 25 and 26 are objected to because of the following informalities:

In claim 25, line 1, -- at least one -- should be inserted before "prong".

In claim 26, line 1, "first" should be changed to -- second -- and it would be considered as such for examination purposes. It is noted that the "second" engagement surface (defined by the second implant" is the one that defines a first end and second end with stops for contacting the prong, i.e. the first engagement surface (see parent claim 25).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-26, 29, and 30, as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Bramlet et al. (U.S. Patent 6,648,889).

Bramlet et al. disclose an implant system comprising a first implant, e.g. 1 (an intramedullary nail), defining a first longitudinal axis, a channel, and a bore 33 in communication with the channel (see Figure 20). The bore 33 is disposed at a predetermined angle with respect to the first longitudinal axis. The system also comprises a second implant comprising a screw 6, a sleeve 3 and a screw 4. The second implant defines a second longitudinal axis and it is slidable along the second longitudinal axis within the bore 33 (see Figure 2). The system further comprises a body member 2 receivable in the channel and

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including at least one prong (see for example Figure 9). The prong and second implant are configured and dimensioned to limit sliding of the second implant (see for example Figures 4 and 5). The system also has a driver member, e.g. 8 (see Figure 6) rotatably coupled to the body member. The driver member is threadably engage within the channel. The body member and drive member are received in the channel. A cannulation is defined through the first implant, body member and drive member (see Figures 2, 8-10, 16). The at least one prong defines a first engagement surface and the second implant defines a second engagement surface (see Figure 5). The second engagement surface has a first end and a second end longitudinally spaced from the first end, and includes stops formed adjacent at least one of the ends (see Figure 14). The second implant includes a plurality of helically twisted threads which can be considered "blades" since they engage the cancellous bone and they are a thin part of a section.

Claims 22, 23, 25, 26, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiwara (Reference "JP9066059" cited on IDS).

Fujiwara discloses an implant system comprising a first implant, e.g. 1 (an intramedullary nail), defining a first longitudinal axis, a channel, and a bore in communication with the channel (see Figure 5). The bore is disposed at a predetermined angle with respect to the first longitudinal axis. The system also comprises a second implant 4. The second implant defines a second longitudinal axis and it is slidable along the second longitudinal axis within the bore (see Figure 5). The system further comprises a body member 9 receivable in the channel and including at least one prong 9a (see Figures 5 and 6). The prong and second implant are configured and dimensioned to limit sliding of the second implant. The system also has a driver member 10 (see Figure 6) rotatably coupled to the body member. The driver member is threadably engage

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within the channel. The body member and drive member are received in the channel. The at least one prong defines a first engagement surface and the second implant defines a second engagement surface 4a (see Figure 5). The second engagement surface has a first end and a second end longitudinally spaced from the first end, and includes stops formed adjacent at least one of the ends (see Figure 5, specifically groove 9a). The second implant includes a plurality of helically twisted threads which can be considered "blades" since they engage the cancellous bone and they are a thin part of a section.

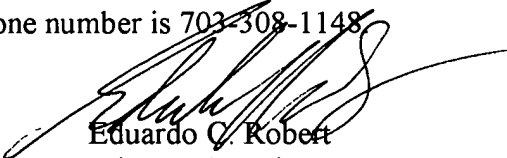
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.